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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,487	01/23/2001	Brian J. Maroney	1671-0172	3262

7590 12/18/2002

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EXAMINER

FERKO, KATHRYN P

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,487

Applicant(s)

MARONEY, BRIAN J.

Examiner

Kathryn Ferko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 8-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Election/Restrictions

1. Claims 8-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

Claims 1-7 remain for examination.

2. The disclosure is objected to because of the following informalities: on page 1, cross-reference is made to a concurrently filed application. It is requested that the serial number be provided. Additionally, on page 19, broach is labeled as element 68; while, on page 20, stem is also referenced as element 68. For consistency, each element should only have one label.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al. (US Patent No. 4,759,350) in view of Trail (EP 0 845 250).

Dunn et al. disclose a tool guide member (55) in a predetermined position relative to a humerus; cutting with a cutting tool (62) while the tool guide member is positioned in the predetermined position relative to the humerus, as stated in 9

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and seen in figures 4-6; securing the tool guide member in the predetermined position relative to the humerus by advancing a surgical instrument (41) into a medullary canal of the humerus such that a distal end portion of the surgical instrument is positioned in the medullary canal and a proximal end portion of the surgical instrument extends out of the medullary canal, as stated in column 8, lines 65-67, column 9, and seen in figure 4; securing the tool guide (55) member to the proximal end portion of the surgical instrument subsequent to the advancing step, as recited in column 10, lines 5-10; securing a support block (40) to the proximal end portion of the surgical instrument, as seen in figure 4; securing the tool guide member (55) to the support block, as seen in figure 5; and securing the support block (40) to the proximal end portion of the surgical instrument (5) with a threaded fastener (41), as stated in column 9.

However, Dunn et al. do not explicitly recite a method of resecting a greater tubercle from a humerus of a patient during performance of a shoulder replacement procedure; cutting the greater tubercle; a surgical instrument that includes an intramedullary broach having a superior face where the tool guide member is secured to the proximal end portion of the surgical instrument by securing the tool guide member to the superior face of the intramedullary broach; a surgical instrument that includes an intramedullary reamer having an elongated shaft where the tool guide member is secured to the proximal end portion of the surgical instrument by securing the tool guide member to the elongated shaft of the intramedullary reamer; or securing the support block to the proximal end

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portion of the surgical instrument by securing the support block to the superior face of the intramedullary broach.

On the other hand, Trail teaches a shoulder replacement device where the structure, would require resecting the greater tubercle from the humerus during the shoulder replacement procedure. Therefore, it would be obvious to one with ordinary skill in the art at the time the invention was made to utilize the cutting guide tool of Dunn et al. to resect the greater tubercle from the humerus during the shoulder replacement procedure of Trail for the purpose of proper fit of the replacement device. Furthermore, although not explicitly recited, it would be obvious to one with ordinary skill in the art and within the scope to have a surgical instrument that includes an intramedullary broach having a superior face where the tool guide member is secured to the proximal end portion of the surgical instrument by securing the tool guide member to the superior face of the intramedullary broach; a surgical instrument that includes an intramedullary reamer having an elongated shaft where the tool guide member is secured to the proximal end portion of the surgical instrument by securing the tool guide member to the elongated shaft of the intramedullary reamer; and to secure the support block to the proximal end portion of the surgical instrument by securing the support block to the superior face of the intramedullary broach.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are as follows: US Patent No. 6,283,999; US Patent No.

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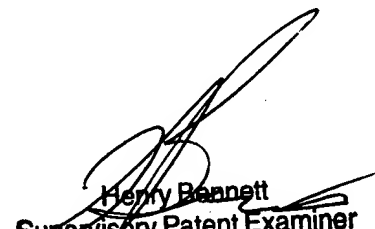
6,171,341; US Patent No. 5,997,543; US Patent No. 5,980,526; US Patent No. 5,817,097; US Patent No. 5,720,752; US Patent No. 5,683,397; US Patent No. 5,540,695; US Patent No. 5,314,479; US Patent No. 5,041,117; US Patent No. 4,893,619; US Patent No. 4,550,450; and GB 2 331 016.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Ferko whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

KF
December 11, 2002


Henry Bennett
Supervisory Patent Examiner
Group 3700